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| TRANSMITTAL FORM (to be used for all correspondence after initial filing) | Application Number | 10/721,039-Conf. #5026 |
| | Filing Date | November 21, 2003 |
| | First Named Inventor | James Anthony Power |
| | Art Unit | N/A |
| | Examiner Name | Not Yet Assigned |
| Total Number of Pages in This Submission | Attorney Docket Number | G0631.70038US00 |

| ENCLOSURES (Check all that apply) | | |
|---|--|---|
| <input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD | <input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Response to Restriction and Election Requirement (4 pgs.) Return Receipt Postcard |
| <div>Remarks</div> | | |

| SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT | | | |
|--|--------------------------------|----------|--------|
| Firm Name | WOLF, GREENFIELD & SACKS, P.C. | | |
| Signature | | | |
| Printed name | Steven J. Henry | | |
| Date | September 8, 2006 | Reg. No. | 27,900 |

| Certificate of Mailing Under 37 CFR 1.8(a) | |
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| I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. | |
| Dated: 9/8/06 | Signature: (Steven J. Henry) |



Docket No.: G0631.70038US00
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: James Anthony Power et al.
Serial No.: 10/721,039
Confirmation No.: 5026
Filed: November 21, 2003
For: INTEGRATED MOS ONE-WAY ISOLATION COUPLER, A
METHOD FOR ONE-WAY COUPLING AN INPUT SIGNAL TO AN
INTEGRATED CIRCUIT, AND A SEMICONDUCTOR CHIP
HAVING AN INTEGRATED MOS ISOLATION ONE-WAY
COUPLER LOCATED THEREON
Examiner: Long Pham
Art Unit: 2814

Certificate of Mailing Under 37 CFR 1.8(a)

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: 9/8/06


Steven J. Henry, Registration No. 27,900

RESPONSE TO RESTRICTION AND ELECTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant is in receipt of the communication mailed August 10, 2006. This communication contains a restriction requirement. It also contains form language relating to a species election requirement, but the species election requirement is unexplicated and does not comply with the MPEP. It expresses only that the patentably distinct species are "various embodiments or species as defined on pages 3-5." As explained to the Examiner by telephone on this date, Applicant has no way of knowing what the Examiner is defining as a species or how many species the Examiner sees. The Examiner agreed that such a statement is a sufficient response to

the election requirement. If the Examiner properly identifies the species he believes to be present, Applicant will consider the matter further.

In response to the restriction requirement, Applicant provisionally elects, with traverse, the Group II claims, claims 1-32, drawn to a semiconductor device.

By way of traversal, Applicant believes the Examiner incorrectly reads the claims and that he therefore reaches an erroneous conclusion that restriction is justified.

The Examiner has concluded that “the product as claimed can be made by another and materially different process such as one in which the MAGNET [sic – presumably MAGFET] is formed on the chip before the formation of the inductor coil.” It appears, from this reasoning, that the Examiner is interpreting the independent method claim 33 as being limited to the inductor coil being formed *under* the MAGFET and as not allowing it to be over the MAGFET. However, the Examiner has clearly misinterpreted claim 33. Claim 33 claims a method for one-way coupling an input signal to an integrated circuit on a semiconductor chip, with the integrated circuit electrically isolated from the input signal. The method according to claim 33 comprises acts of, *inter alia*:

fabricating an inductor coil on the semiconductor chip...,
fabricating a MAGFET on the semiconductor chip..., and
electrically isolating the MAGFET from the inductor coil....

Thus, the method of claim 33 merely requires the fabrication of an inductor coil, a MAGFET and electrically isolating the MAGFET from the inductor coil. There is no limitation in claim 33 as to the order in which these acts need be carried out or which element is on top and which is on bottom. It is black letter law that the steps in a method claim can be carried out in any order unless the claim language expressly or implicitly requires a specific order. Moreover, the specification teaches no limitation as to the order in which the acts are to be carried out. The contrary is, in fact, true. For example, at page 6, lines 1-2, it is stated: “...the MAGFET can be placed *under or over* the inductor coil at the centre thereof...” (Emphasis added.) Also, in the specific description of the exemplary embodiment, with reference to Figs. 1-7, the MAGFET 10 is clearly disclosed as being formed beneath the conductor coil 4. At page 8, lines 25-28, the application clearly states:

On completion of the formation of the MAGFET 10, and the associated integrated circuits 2, the oxide layer 7 is deposited over the MAGFET 10. The inductor coil is then formed on the oxide layer 7 by a conventional CMOS deposition and etching process.

Yet, it is further stated on page 15, from lines 12-16:

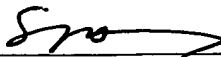
While the MAGFET 10 has been described as being located beneath in the inductor 4, the MAGFET 10 may be located above the inductor coil 4, or in any suitable location so that the magnetic field generated by the inductor coil 4 cuts the plane of the channel 13 of the MAGFET 10 substantially at right angles thereto.

In an integrated circuit fabrication process, if the MAGFET is to be located beneath the inductor coil, the MAGFET typically would have to be fabricated before the inductor coil. If the MAGFET were to be located above the inductor coil, in the usual fabrication, it would have to be fabricated after the inductor coil. Thus, there is a clear disclosure that the acts of the method can be carried out in any order. The claims have to be interpreted consistently with that disclosure. When the claims are so understood, the Examiner's reasoning falls apart and there is no basis for his conclusion that "the product as claimed can be made by another and materially different process such as one in which the MAGNET is formed on the chip before the formation of the inductor coil." The hypothesized "materially different" process is, in fact, the claimed process. Thus, there is no distinctness or independence between the method and product claims. Moreover, when the method claims are properly construed as to their scope, it is clear that different searches are not required. Accordingly, Applicant requests that the restriction requirement be withdrawn.

In response to the restriction requirement set forth in the Office Action mailed August 10, 2006, applicant hereby provisionally elects claims for continued examination, with traverse.

Dated: September 8, 2006

Respectfully submitted,

By 

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